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10/551,794	11/28/2006	Hidehisa Takahashi	1560-0440PUS1	4249
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BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				UBER, NATHAN C
ART UNIT		PAPER NUMBER		
3622				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/551,794	TAKAHASHI, HIDEHISA	
	<b>Examiner</b>	<b>Art Unit</b>	
	NATHAN C. UBER	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 28 November 2006.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 13-36 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 13-36 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 27 September 2005, 30 September 2008, 18 February 2009.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_ .

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.



## DETAILED ACTION

### Status of Claims

1. This action is in reply to the 371 national stage entry application filed on 28 November 2006.
2. Claims 13-36 have been added by preliminary amendment.
3. Claims 1-12 have been canceled by preliminary amendment.
4. Claims 13-36 are currently pending and have been examined.

### Information Disclosure Statement

5. The Information Disclosure Statements filed 27 September 2005, 30 September 2008 and 18 February 2009 have been considered. Initialed copies of the Form 1449 are enclosed herewith.

### Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 35 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to a particular machine or apparatus (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claim 35 fails to meet the above requirements because it is neither tied to a particular machine nor does it transform underlying subject matter. Examiner notes that the *issuing* and *receiving* limitations indicate a server and user terminal, however these data

transfer steps are considered insignificant extra-solution activity and are incapable of imparting patent eligibility to the claim under 35 USC 101 (see *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008)).

### **Claim Rejections - 35 USC § 102**

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.
9. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).
10. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.
11. Claims 13-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Boyd et al. (U.S. 7,424,617 B2).

#### **Claim 13:**

Boyd, as shown, discloses the following limitations:

- *recording means for recording a program or data* (see at least figures 12 and 13, item 400, web server storing therein or communicatively linked to at least a database; see also at least column 53, lines 46-62, a network of servers and databases and/or all databases stored on a single server hard drive),
- *data communication controlling means for causing a user terminal to execute the program recorded in said recording means through a communication line, or for downloading the recorded program or data to the user terminal, comprising* (see at least column 52, lines 57-62, the user connects over the internet to the server computer and interacts with the program stored on the server; see also at least column 51, lines 42-64, the network architecture, see also at least figure 1),
- *code train issuing means for issuing a code train and also for transmitting said code train to said data communication controlling means* (see at least column 53, lines 11-13, user enters the 10-digit code, see also at least figure 14(B); see also at least column 52, lines 63-64, the web server is coupled to the code server/production database and the user database; see also at least column 58, lines 54-55 generating codes for dissemination in bottle caps),
- *code train receiving means for receiving the code train transmitted from said user terminal through the communication line* (see at least column 53, lines 11-13, user enters the 10-digit code, see also at least figure 14(B); see also at least column 52, lines 63-64, the web server is coupled to the code server/production database and the user database),
- *code train judging means for judging whether or not said received code train conforms with predetermined condition corresponding to said issued code*

*train* (see at least column 53, lines 11-13, the server verifies the entered code with the code database),

- *authorizing means for authorizing the user terminal that transmitted said code train to execute said program, continue the program being executed, download the program, or download data, when said received code train conforms with said predetermined condition* (see at least column 53, lines 13-14, if the code is valid the user's account is updated with the points associated with the code; see further at least column 53, lines 21-33, the user is provided access to sites where points may be redeemed for soft goods such as downloadable music or downloadable software).

**Claim 20:**

Boyd, as shown, discloses the following limitations:

- *recording means for recording a program or data* (see at least figures 12 and 13, item 400, web server storing therein or communicatively linked to at least a database; see also at least column 53, lines 46-62, a network of servers and databases and/or all databases stored on a single server hard drive),
- *a first server capable of notifying a code train to a user terminal through a communication line* (see at least column 57, lines 66-67 and column 58, line 1, a special 12-digit code is issued to the user over the network so the user can download a purchased data file or program),
- *data communication controlling means for causing a user terminal to execute the program recorded in said recording means through a communication line, or for downloading the recorded program or data to the user terminal, comprising* (see at least column 52, lines 57-62, the user connects over the internet to the server computer and interacts with the program stored on the server; see also at least column 51, lines 42-64, the network architecture, see also at least figure 1),

- *code train receiving means for receiving the code train transmitted from said user terminal through the communication line* (see at least column 53, lines 11-13, user enters the 10-digit code, see also at least figure 14(B); see also at least column 52, lines 63-64, the web server is coupled to the code server/production database and the user database),
- *code train judging means for judging whether or not said received code train conforms with predetermined condition corresponding to said issued code train* (see at least column 53, lines 11-13, the server verifies the entered code with the code database),
- *authorizing means for authorizing said user terminal that transmitted said code train to execute said program, continue the program being executed, download the program or download the data, when said received code train conforms with said predetermined condition* (see at least column 53, lines 13-14, if the code is valid the user's account is updated with the points associated with the code; see further at least column 53, lines 21-33, the user is provided access to sites where points may be redeemed for soft goods such as downloadable music or downloadable software).

**Claim 27:**

Boyd, as shown, discloses the following limitations:

- *recording means for recording a program or data* (see at least figures 12 and 13, item 400, web server storing therein or communicatively linked to at least a database; see also at least column 53, lines 46-62, a network of servers and databases and/or all databases stored on a single server hard drive),
- *a first server capable of transmitting a code train to a user terminal through a communication line* (see at least column 57, lines 66-67 and column 58, line 1, a special 12-digit code is issued to the user over the network so the user can download a purchased data file or program),

- *data communication controlling means for allowing said user terminal to execute the program or data recorded in said recording means, or for downloading the program from said recording means to said user terminal, comprising (see at least column 52, lines 57-62, the user connects over the internet to the server computer and interacts with the program stored on the server; see also at least column 51, lines 42-64, the network architecture, see also at least figure 1),*
- *means for, by preliminarily downloading, causing said user terminal to execute a management program that causes said user terminal to receive and record the code train transmitted from said first server, and to transmit said recorded code train to a predetermined destination from said user terminal (see at least column 20, lines 28-29, 34-35, 60-62, column 21, lines 5-6, 21-23, the user is rewarded for viewing an advertisement, the points/codes are automatically verified and deposited in the appropriate database indicating that the user saw the ad and is entitled to some reward, in the case of the Boyd reference the award is tied to points),*
- *code train receiving means for receiving the code train transmitted from said user terminal through the communication line (see at least column 53, lines 11-13, user enters the 10-digit code, see also at least figure 14(B); see also at least column 52, lines 63-64, the web server is coupled to the code server/production database and the user database),*
- *code train judging means for judging whether or not said received code train conforms with the predetermined condition corresponding to the code train transmitted to a user terminal from said first server (see at least column 53, lines 11-13, the server verifies the entered code with the code database; see also at least column 20, lines 60-61 and column 21, lines 5-6, validating and verifying restrictions),*

- *authorizing means for authorizing said user terminal that transmitted said code train to execute said program, continue the program being executed, download the program, or download the data, when said received code train conforms with said predetermined condition* (see at least column 53, lines 13-14, if the code is valid the user's account is updated with the points associated with the code; see further at least column 53, lines 21-33, the user is provided access to sites where points may be redeemed for soft goods such as downloadable music or downloadable software).

**Claims 14, 21 and 28:**

Boyd, as shown, discloses the following limitations:

- *said program is a program that starts or continues according to points associated with the user* (see at least column 17, lines 31-33, customer services and subscriptions; Examiner notes that these are online services, see at least column 17, lines 39-40, points may be redeemed offline as well),
- *said authorizing means changes said points depending on said code train when execution of said program or continuation of the program are authorized* (see at least column 12, lines 44-54, debiting and crediting the user point account based on point accrual activities and point redemption activities).

**Claims 15, 22 and 29:**

Boyd, as shown, discloses the following limitations:

- *point managing means for associating identification information for identifying the user operating said user terminal or the user terminal with points of said user or user terminal identified by said identification information and records them* (see at least column 12, lines 39-54 and 66-67; user database and relation database are each synchronized and each store and associate user information with points and activity information),

- *code train information managing means for associating the code train with the points and records them* (see at least column 13, line relational database records and tracks all transaction including the user ID, points earned and the actions the user took to earn the points, etcetera),
- *extracting means for extracting the points associated with the code train received from said user terminal, from said code train information managing means* (see at least column 12, lines 47-48, the user database is used for redemptions),
- *wherein said authorizing means change the points associated with said identification information by said point managing means based on the points extracted by said extracting means when execution of said program, continuation of the program being executed, downloading of the program, or downloading of the data are authorized* (see at least column 12, lines 44-54, debiting and crediting the user point account based on point accrual activities and point redemption activities).

**Claims 16, 23 and 30:**

Boyd, as shown, discloses the following limitations:

- *comprising code train generating means for generating a code train based on said identification information* (see at least column 57, lines 66-67 and column 58, line 1, a special 12-digit code is issued uniquely to the user over the network so the user can download a purchased data file or program),
- *wherein said point managing means associates the identification information, the code train generated based on said identification information and the points* (see at least column 12, lines 39-54 and 66-67; user database and relation database are each synchronized and each store and associate user information with points and activity information).

**Claims 17, 24 and 31:**

Boyd, as shown, discloses the following limitations:

- *said point managing means associates a history of the code train related to the change of the points with the identification information and records them, and determines said predetermined condition based on the history recorded in association with said identification information* (see at least column 16, lines 9-17, examples of ways to award points to an account based on the account history, inherently the system must record a history of the codes the user activity to enable these features).

**Claims 18, 25 and 32:**

Boyd, as shown, discloses the following limitations:

- *said point managing means records data related to available period associated with the code train determines said predetermined condition, based on the data related to the available period recorded in association with said code train* (see at least column 17, lines 54-67, expiration dates may be set for points or offers).

**Claims 19, 26 and 33:**

Boyd, as shown, discloses the following limitations:

- *attribute information requesting means for causing said user terminal to input attribute information indicative of attributes of the user identified by the identification information and to transmit the inputted attribute information* (see at least column 14, lines 64-67, registration includes providing personal demographic/attribute information),
- *means for recording said attribute information in association with the identification information in said point managing means, when receiving from said user terminal the attribute information indicative of the attributes of the user identified by the identification information* (see at least column 14, lines

64-67, see also at least column 15, lines 7-8, merchant sets up an account associating user information with user identification),

- *privilege granting means for granting a privilege to the user identified by the identification information recorded in association with the attribute information when the points recorded in association with said point managing means satisfy a predetermined numeric condition* (see at least column 15, lines 7-10, merchant credits the user's account with points for registering the account and providing the requested information).

**Claim 34:**

Boyd, as shown, discloses the following limitations:

- *a service server capable of communicating with a user terminal through a communication line* (see at least figures 12 and 13, item 400, web server storing therein or communicatively linked to at least a database; see also at least column 53, lines 46-62, a network of servers and databases and/or all databases stored on a single server hard drive),
- *code train issuing means for issuing a code train and also transmitting said code train to said service server, comprising* (see at least column 53, lines 11-13, user enters the 10-digit code, see also at least figure 14(B); see also at least column 52, lines 63-64, the web server is coupled to the code server/production database and the user database; see also at least column 58, lines 54-55 generating codes for dissemination in bottle caps),
- *code train receiving means for receiving the code train transmitted from said user terminal through the communication line* (see at least column 53, lines 11-13, user enters the 10-digit code, see also at least figure 14(B); see also at least column 52, lines 63-64, the web server is coupled to the code server/production database and the user database),

- *code train judging means for judging whether or not said received code train conforms with the predetermined condition corresponding to said issued code train* (see at least column 53, lines 11-13, the server verifies the entered code with the code database),
- *authorizing means for authorizing the user terminal that transmitted said code train to provide services or continue services being provided, when said received code train conforms with said predetermined condition* (see at least column 53, lines 13-14, if the code is valid the user's account is updated with the points associated with the code; see further at least column 53, lines 21-33, the user is provided access to sites where points may be redeemed for soft goods such as downloadable music or downloadable software; see also at least column 17, lines 31-33, redeeming points in exchange for the use of online services).

**Claim 35:**

Boyd, as shown, discloses the following limitations:

- *issuing the code train and also transmitting said code train to said service server* (see at least column 53, lines 11-13, user enters the 10-digit code, see also at least figure 14(B); see also at least column 52, lines 63-64, the web server is coupled to the code server/production database and the user database; see also at least column 58, lines 54-55 generating codes for dissemination in bottle caps),
- *receiving the code train transmitted from said user terminal, through the communication line* (see at least column 53, lines 11-13, user enters the 10-digit code, see also at least figure 14(B); see also at least column 52, lines 63-64, the web server is coupled to the code server/production database and the user database),

- *judging whether or not said received code train conform with the predetermined condition corresponding to said issued code train* (see at least column 53, lines 11-13, the server verifies the entered code with the code database),
- *authorizing the user terminal that transmitted said code train to provide services or continue the service being provided, when said received code train conforms with said predetermined condition* (see at least column 53, lines 13-14, if the code is valid the user's account is updated with the points associated with the code; see further at least column 53, lines 21-33, the user is provided access to sites where points may be redeemed for soft goods such as downloadable music or downloadable software).

**Claim 36:**

Boyd, as shown, discloses the following limitations:

- *data communication controlling means for communicating with a user terminal through a communication line, and provides a program or data to said user terminal, said computer program product comprises* (see at least column 52, lines 57-62, the user connects over the internet to the server computer and interacts with the program stored on the server; see also at least column 51, lines 42-64, the network architecture, see also at least figure 1),
- *a computer readable storage medium having computer readable program code means embodied in said medium, said computer readable program code means comprising computer instruction means for* (see at least figures 12 and 13, item 400, web server storing therein or communicatively linked to at least a database; see also at least column 53, lines 46-62, a network of servers and databases and/or all databases stored on a single server hard drive),

- *receiving a code train transmitted from code train issuing means through the communication line* (see at least column 53, lines 11-13, user enters the 10-digit code, see also at least figure 14(B); see also at least column 52, lines 63-64, the web server is coupled to the code server/production database and the user database),
- *judging whether or not said received code train conforms with predetermined condition corresponding to the code train transmitted from said code train issuing means when receiving the code train transmitted from said user terminal through the communication line* (see at least column 53, lines 11-13, the server verifies the entered code with the code database),
- *authorizing said user terminal to execute said program, continue the program being executed, download the program or download the data, when said received code train conforms with predetermined condition* (see at least column 53, lines 13-14, if the code is valid the user's account is updated with the points associated with the code; see further at least column 53, lines 21-33, the user is provided access to sites where points may be redeemed for soft goods such as downloadable music or downloadable software).

Art Unit: 3622

### **Conclusion**

12. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 8:30am-4:00pm EST. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.
13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
14. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

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or faxed to **571-273-8300**.

15. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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/Nathan C Uber/ Examiner, Art Unit 3622  
28 April 2009

/Arthur Duran/  
Primary Examiner, Art Unit 3622